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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,577	08/19/2003	Tetsuya Yoshida	Q76401	2953

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SUGHRUE MION, PLLC  
2100 PENNSYLVANIA AVENUE, N.W.  
SUITE 800  
WASHINGTON, DC 20037

EXAMINER

WOODWARD, ANA LUCRECIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/642,577

Applicant(s)

YOSHIDA ET AL.

Examiner

Ana L. Woodward

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on December 27, 2004
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 17-20, the metes and bounds of the heat-resistance imparting agents are indeterminate in scope. As presently recited, no distinction can be seen between the heat-resistance imparting agents and the inorganic filler component of the base claim. Accordingly, said components read on one and the same entity.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. 5,648,433 (Scott) or U.S. 6,114,472 (Matsuki et al) each in view of EP 1199333 and further in view of U.S. 5,747,560 (Christiani et al).

Each of Scott and Matsuki et al disclose visually clear bends comprising polyetherimides, reading on applicants' polyetherimide, and polyesters of 2-6 naphthalene dicarboxylic acid, reading on applicants' polymer containing polyethylene naphthalate units (see abstract of Scott and examples 14-22 of Matsuki et al). Each reference discloses that fillers and other additives

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can be further incorporated into their transparent blends (Scott at column 7, lines 9-12 and Matsuki et al at column 9, lines 47-57).. Polyester copolymers additionally containing terephthalic acid units, as per present claims 3 and 4, are disclosed by Scott at column 5, lines 48-50 and Matsuki et al at column 4, lines 30-31.

The references differ in essence from the present claims in not expressly exemplifying the use of an inorganic filler. The addition of up to 70 percent by weight of inorganic fillers for the purpose of imparting heat resistance and strength to compositions comprising polyetherimide and semi-aromatic polyester, wherein the polyester can be derived from naphthalene dicarboxylic acid, is well known in the art as per EP '333 (pages 10-11). Noted is the use of glass fibers and their proportion relative to the polyetherimide per example 4. Accordingly, it would have been obvious to one having ordinary skill in the art to have added an inorganic filler in conventional amounts (inclusive of amounts per claims 5-11) for its expected additive effect into the compositions of Scott and Matsuki et al with the reasonable expectation of success. This is particularly so since Scott and Matsuki et al each expressly disclose that fillers can be additionally incorporated into their respective transparent compositions.

With respect to the claims 12-16 requiring a swellable, lamellar silicate as the inorganic filler, it would have been obvious to use a mica or clay in the form of a swellable-layered material as the filler material in the compositions of Scott and Matsuki et al because Christiani et al teach that said materials are compatible with polymers inclusive of polyesters, such as poly(ethylene 1,5-naphthalate), and polyetherimides, and blends of said polymers (column 17, lines 25, 35 and 66). As to claims 17-20, the additional use of stabilizers is within the scope of

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the disclosures of Scott and Matsuki et al. Accordingly, absent evidence of unusual or unexpected results, no patentability can be seen in the presently claimed invention.

***Response to Arguments***

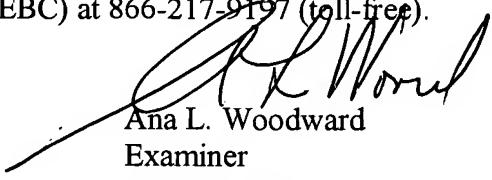
4. Applicant's arguments filed December 27, 2004 have been fully considered and are persuasive to the extent that the rejection based on Scott U.S. 6,252,011 has been withdrawn. Specifically, it is agreed that Scott '011 does not provide sufficient motivation to add an inorganic filler.

***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ana L. Woodward whose telephone number is (571) 272-1082. The examiner can normally be reached on Monday-Friday (8:30-5:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ana L. Woodward  
Examiner  
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